

## **Remarks**

These Remarks are in reply to the Office Action mailed February 7, 2008

### **I. Summary of Examiner's Rejections**

Prior to the Office Action mailed February 7, 2008, Claims 1-30 were pending in the Application. In the Office Action, Claim 22 was objected to as containing an informality. Claims 2, 7, 14 and 26-28 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1-23 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna et al. (U.S. Patent No. 7,054,905, hereinafter Hanna) in view of Arnold (U.S. Patent No. 6,275,848, hereinafter Arnold). Claims 24, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna in view of Arnold and further in view of Le Pennec et al. (U.S. Publication No. 2005/0076082).

### **II. Summary of Applicants' Amendment**

The present Response amends Claims 1, 2, 5-7, 12, 14, 19, 25-28 and 30, and cancels Claim 13, leaving Claims 1-12 and 14-30 for the Examiner's present consideration. Reconsideration of the Application, as amended, is respectfully requested.

### **III. Claim Objection**

In the Office Action mailed February 7, 2008, Claim 22 was objected to as containing an informality. More specifically, it was proposed that the term "determining an identity of a sender" was not being supported by the Specification, which instead referred to "identity of the recipient." (Office Action, page 2).

Applicants respectfully disagree. The feature of "determining the identity of the sender" recited in Claim 22 is fully supported on paragraph [0041], as well as other portions of the present Specification. For example, see "message parser 345 then identifies 510 the user who sent the message... then checks 515 the user preference file 400 associated with the sender of the message to determine the message parsing preferences associated with the sender of the message." (Specification, par. [0041]). Accordingly, Applicants respectfully submit that Claim

22 is fully supported by the Specification as originally filed and reconsideration thereof is respectfully requested.

**IV. Claim Rejections under 35 U.S.C. §112, second paragraph**

In the Office Action mailed February 7, 2008, Claims 2, 7, 14 and 26-28 were rejected under 35 U.S.C. § 112, second paragraph. More particularly, the limitation “the attachment” was rejected as having insufficient antecedent basis in the claim.

The present Response hereby amends Claims 2, 7, 14 and 26-28 so as to correctly provide proper antecedent basis for the limitations therein. Applicants respectfully submit that as amended, Claims 2, 7, 14 and 26-28 now comply with the requirements of 35 U.S.C. § 112, second paragraph and reconsideration thereof is respectfully requested.

**V. Claim Rejections under 35 U.S.C. §103(a)**

In the Office Action mailed February 7, 2008, Claims 1-23 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna et al. (U.S. Patent No. 7,054,905, hereinafter Hanna) in view of Arnold (U.S. Patent No. 6,275,848, hereinafter Arnold). Claims 24, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna in view of Arnold and further in view of Le Pennec et al. (U.S. Publication No. 2005/0076082, hereinafter Pennec).

**Claim 1**

Claim 1 has been amended to more clearly define the embodiment therein. As amended, Claim 1 defines:

- 1. A method for processing electronic mail messages, the method comprising:*
  - accepting an electronic mail message, the electronic mail message including a file attachment;*
  - removing the file attachment from the electronic mail message;*
  - storing the file attachment in an attachment location;*
  - inserting a hyperlink in the message, the hyperlink associated with the attachment location, wherein the hyperlink causes submission of validation information to a server storing the file attachment;*
  - receiving a retrieval request from a recipient of the electronic mail message; and*

*performing transduction on the file attachment by the server storing the file attachment prior to providing the file attachment to the recipient.*

As amended, Claim 1 defines receiving an email message and removing the file attachment from the message. The file attachment is stored in a location on a remote server for example. A hyperlink is inserted into the message, which will cause the submission of validation information to a server that stores the attachment. Once a request to retrieve the message is received, the server that is storing the file attachment can automatically perform transduction on the file attachment before providing it to the recipient.

The advantages of the features defined in Claim 1 include the ability to automatically perform transduction on the file by the attachment server. The transduction would modify the file by compressing it, changing it to a more bandwidth efficient or accessible format, reducing the size or resolution of the images, translation of text in the file and streaming of media files. (e.g. Specification, par. [0023]). Thus, the attachment server can enable a smooth and complete file sharing ability via email.

Hanna teaches replacing an email attachment with an address specifying where the attachment is stored. More specifically, the system described in Hanna appears to examine an email message and if the email message includes an attachment, the system stores the attachment on the network, replacing the attachment in the message with a reference to its location. The modified message is then sent to the recipient.

Arnold teaches a method and apparatus for automated referencing of electronic information. More specifically, Arnold appears to describe receiving a message and applying a set of detachment rules to the message. The message is then sent to a recipient. However, Applicants respectfully submit that Hanna in combination with Arnold fail to disclose the features of Claim 1, as amended.

For example, Hanna in combination with Arnold fail to disclose the step of performing transduction by the server storing the file attachment prior to providing the file attachment to the recipient, as defined in amended Claim 1. Neither Hanna, nor Arnold perform any transduction on the file attachments. For example, neither of the references describe that the attachment server automatically translates the text in the attachment or generates a low bandwidth version of the attachment, as defined in the present embodiments. This feature of Claim 1 allows the

attachment server to assist in sharing of electronic attachments by applying various transduction techniques to the attachments. No such feature is disclosed in the cited references.

In view of the above comments, Applicants respectfully submit that Claim 1, as amended, is neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

#### **Claim 5**

Claim 5 has been amended to more clearly define the embodiment therein. As amended, Claim 5 defines:

*5. A method for processing electronic mail messages, the method comprising:  
accepting an electronic mail message, the electronic mail message including a file attachment;  
determining whether to remove the file attachment;  
in response to a positive determination, storing the file attachment in an attachment location; and  
inserting in the message, an executable file that automatically submits validation information to a server storing the file attachment and retrieves the file attachment from the attachment location.*

As amended, Claim 5 further defines inserting into the message an executable file that automatically submits validation information to the server and retrieves the attachment from the attachment location. This feature allows a more automated approach by including an actual executable file into the email message, rather than a mere hyperlink (URL). As such, rather than requiring the user to manually go to the hyperlink and download the attachment, the executable file can perform this function by automatically authenticating the user to the attachment server and then downloading the file attachment. This can enable a simpler user experience of opening the message, rather than having to follow hyperlinks in order to manually download the attachments.

Hanna in combination with Arnold fail to disclose the step of inserting into the message an executable file that automatically retrieves the attachment from the attachment location, as defined in amended Claim 5. For example, at most, Hanna merely contemplates forwarding a URL along with the email message. There is no description of embedding any executable files into the email message as defined in amended Claim 5. More specifically, Hanna does not disclose inserting an executable file that automatically submits validation information to the

attachment server and then automatically retrieves the attachment from the attachment server, as defined in amended Claim 5.

In view of the above comments, Applicants respectfully submit that Claim 5, as amended, is neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

#### **Claims 12 and 19**

Claims 12 and 19, while independently patentable, recite limitations that, similarly to those described above with respect to Claims 1 and 5, are not taught, suggested nor otherwise rendered obvious by the cited references. Reconsideration thereof is respectfully requested.

#### **Claims 2-4, 6-11, 13-18 and 20-30**

Claims 2-4, 6-11, 13-18 and 20-30 are not addressed separately, but it is respectfully submitted that these claims are allowable as depending from an allowable independent claim, and further in view of the comments provided above. Applicants respectfully submit that Claims 2-4, 6-11, 13-18 and 20-30 are similarly neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

It is also submitted that these claims also add their own limitations which render them patentable in their own right. Applicants respectfully reserve the right to argue these limitations should it become necessary in the future.

#### **VI. Conclusion**

In view of the above remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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